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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,212	09/15/2004	Miki Murakami	257756US6PCT	1787
22850	7590	02/25/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			QAYYUM, ZESHAN	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			02/25/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/507,212	MURAKAMI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ZESHAN QAYYUM	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 January 2009.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-8,14 and 15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 3-8, 14-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### **Status of Claims**

1. Claims 1, 3-8, 14-15 have been examined.

### ***Response to Arguments***

2. Applicant is of the opinion that the prior art fails to teach the limitation "a content copy certificate that contains a license for a move destination client". The Examiner respectfully disagrees. Hurst discloses this limitation in Column 8, lines 24-58.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-8 and 14-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1, 14 and 15 recite the limitation "the move source client" in last line. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 3-8 are also rejected as each depend from claim 1.
6. Claim 8 recites the limitation "the amount" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 15 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-8 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abburi (US 7203966) in view of Hurst (US 7149545).
9. With respect to claims 1, and 14-15, Abburi discloses: registration means for registering each client of the user and acquiring customer-related information (See column 57,lines 65-67 and column 58, lines 1-6, 55-67 ) customer-related information management means for managing customer-related information (See column 58,lines 55-67 and column 59, lines 1-10) contents supply means for supplying contents to a client in compliance with a request from the client (See column 2,lines 51-67, column 3, lines 1-4) license supply means for supplying, in compliance with a request from a client, a license for contents acquired from said contents supply means to the client who has acquired the contents;(See column 2, lines 63-67 and column 3, lines 1-11 ). Abburi does not explicitly disclose: contents copy certificate supply means for generating a contents copy certificate that contains a license for a move destination client, and supplying the contents copy certificate, which also indicates a contents move from one client of the user to an other is legal, to the move source client. Hurst discloses: contents copy certificate supply means

for generating a contents copy certificate that contains a license for a move destination client, and supplying the contents copy certificate, which also indicates a contents move from one client of the user to an other is legal, to the move source client (See column 8, lines 24-58). Therefore it would have been obvious to one of the ordinary skill in the art at the time of invention was made to modify Abburi reference by adding transfer rights of Hurst. One of ordinary skill in the art would have been motivated to modify the reference as described above in order to provide content security.

In addition with respect to “which also indicates a contents move from one client of the user to an other is legal, to the move source client” it is intended use of content copy certificate. Therefore, it has been held While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)

10. With respect to claim 3, Abburi in view of Hurst discloses all the limitations as described above. With respect to wherein the contents move source client and the contents move destination client are registered with different license supply means so that each license supply means supplies its own public key to the registered client, and wherein said contents copy certificate supply means electronically signs the contents copy certificate with a secret key of a license supply means with which

the contents move destination client is registered. This is functional language/intended use of content distribution system. However, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. (MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

11. With respect to claim 4, Abburi in view of Hurst discloses all the limitations as described above. With respect to "wherein said contents copy certificate supply means acquires a license ID concerning the contents to be moved and the client ID of a move destination client from said contents move source client, sends an inquiry to said customer-related information management means to verify that the move source client is legal, and that the move source client has already acquired a license for the contents to be moved, and further that the user owning the move source client actually owns the move destination client, and then supplies a contents copy certificate". This is functional language/intended use of contents copy certificate supply mean. However, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. (MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

12. With respect to claim 5, Abburi in view of Hurst discloses all the limitations as described above. Abburi further discloses: wherein said customer-relate information management means manages a table (See column 58, lines 55-67 and Fig 25) With respect to "defining the association between leaf IDs and client IDs, a table defining the association between client IDs and client public key certificates, a table defining the association between client IDs and user IDs, a table defining the association between contents IDs and license IDs, a table defining the association between user IDs and contents IDs of downloaded contents, a table defining the association between user IDs and license IDs of downloaded licenses, and a history of contents copy certificate issues" these are nonfunctional descriptive material. It is describing the data stored in the table. Therefore it has been held stored data will not distinguish the invention from the prior art in term of patentability. (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

13. With respect to claim 6, Abburi in view of Hurst discloses all the limitations as described above. Abburi further discloses: wherein said customer-related information management means updates the customer-related information each time said contents supply means supplies contents to a client and/or each time said license supply means supplies a license to a client. (See column 61, lines 7- 24, 30-42 and column 62, lines 43-65).

14. With respect to claim 7, Abburi in view of Hurst discloses all the limitations as described above. Abburi further discloses: further comprising billing process means for performing a billing process on a client in accordance with a license supply and/or a contents copy certificate supply to the client. (See column 21, lines 35-46 and column 22, lines 43-52).

15. With respect to claim 8, Abburi in view of Hurst discloses all the limitations as described above. Abburi further discloses: the amount billed (i.e. fee) by said billing process means for a license supply ((See column 21, lines 35-46 and column 22, lines 43-52). Hurst discloses: the amount billed for a contents copy certificate (i.e. rights) supply (See column 5, lines 5-11 and 21-22). Further it would be a predictable result of a provider charging a user for license supply and content copy certificate supply to charge any amount for the content that the provider desired. (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/507,212  
Art Unit: 3685

Page 10

/Z. Q./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685